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OFFICE OF PETITIONS

In re Application of :
Zierenberg et al. :
Application No. 10/617,804 :
Filed: July 14, 2003 :
Attorney Docket No. 0652.206002/ALF/MJM :

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.182, filed July 20, 2005, to withdraw a terminal disclaimer.

In the present petition, petitioners request that the Office withdraw the terminal disclaimer filed on February 22, 2005, because it is unnecessary. Specifically, petitioners argue that they filed the terminal disclaimer in response to an improper double patenting rejection.

Initially, the Office notes that petitioners submitted the Fee(s) Transmittal (Form PTOL-85B) and paid the issue fee on June 22, 2005, in response to the Notice of Allowance and Fee(s) Due. On July 20, 2005, petitioners filed the present petition. Thereafter, the above-identified application proceeded to issue as a patent on August 23, 2005, before the petition reached an appropriate USPTO official to decide it on the merits.

Petitioners are reminded that an allowed application may issue as a patent approximately four weeks after payment of the issue fee. The Office cannot ensure that any post allowance correspondence will reach the appropriate USPTO official for consideration before the date the application issues as a patent. Therefore, the Office encourages petitioners to file any necessary petitions or other papers prior to paying the issue fee, preferably within one month after the mailing of the Notice of Allowance. *See* MPEP 502; 1308. If timely requested, the Office may grant a petition to withdraw a recorded terminal disclaimer before the application in which it is filed issues as a patent. However, it is unlikely that a recorded terminal disclaimer will be nullified after the application issues as a patent. *See* MPEP 1490.

Unfortunately, petitioners did not submit the present petition in a timely manner to ensure that it would reach an appropriate USPTO official for consideration before the date the application issued as a patent. Section 1490 (B) of the Manual for Patent Examining Procedure discusses the policy of the USPTO regarding the withdrawal of a terminal disclaimer after issuance of a patent.

Section 1490(B) states in pertinent part:

The mechanisms to correct a patent — Certificate of Correction (35 U.S.C. 255), reissue (35 U.S.C. 251), and reexamination (35 U.S.C. 305) — are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer. As a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner — e.g., intervening rights in the case of a reissue patent. *See, e.g., Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U.S. 477, 24 USPQ 308 (1935).

Certificates of Correction (35 U.S.C. 255) are available for the correction of an applicant's mistake. The scope of this remedial provision is limited in two ways — by the nature of the mistake for which correction is sought and the nature of the proposed correction. *In re Arnott*, 19 USPQ2d 1049 (Comm'r Pat. 1991). The nature of the mistake for which correction is sought is limited to those mistakes that are:

- (A) of a clerical nature,
- (B) of a typographical nature, or
- (C) of a minor character.

The nature of the proposed correction is limited to those situations where the correction does not involve changes which would:

- (A) constitute new matter, or
- (B) require reexamination.

A mistake in filing a terminal disclaimer does not fall within any of the categories of mistake for which a certificate of correction of applicant's mistake is permissible, and any attempt to remove or nullify the effect of the terminal disclaimer would typically require reexamination of the circumstances under which it was filed.

Although the remedial nature of reissue (35 U.S.C. 251) is well recognized, reissue is not available to correct all errors. It has been the Office position that reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent. First, the reissue statute only authorizes the Director of the USPTO to reissue a patent "for the unexpired part of the term of the original patent." Since the granting of a reissue patent without the effect of a recorded terminal disclaimer would result in extending the term of the original patent, reissue under these circumstances would be contrary to the statute. Second, the principle against recapturing something that has been intentionally dedicated to the public dates back to *Leggett v. Avery*, 101 U.S. 256 (1879). The attempt to restore that portion of the patent term that was dedicated to the public to secure the grant of the original patent would be contrary to this recapture principle. Finally, applicants have the opportunity to challenge the need for a terminal disclaimer during the prosecution of the application that issues as a patent. "Reissue is not

a substitute for Patent Office appeal procedures.” *Ball Corp. v. United States*, 729 F.2d 1429, 1435, 221 USPQ 289, 293 (Fed. Cir. 1984). Where applicants did not challenge the propriety of the examiner’s obvious-type double patenting rejection, but filed a terminal disclaimer to avoid the rejection, the filing of the terminal disclaimer did not constitute error within the meaning of 35 U.S.C. 251. *Ex parte Anthony*, 230 USPQ 467 (Bd. App. 1982), *aff’d*, No. 84-1357 (Fed. Cir. June 14, 1985).

Finally, the nullification of a recorded terminal disclaimer would not be appropriate in a reexamination proceeding. There is a prohibition (35 U.S.C. 305) against enlarging the scope of a claim during a reexamination proceeding. As noted by the Board in *Anthony*, *supra*, if a terminal disclaimer was nullified, “claims would be able to be sued upon for a longer period than would the claims of the original patent. Therefore, the vertical scope, as opposed to the horizontal scope (where the subject matter is enlarged), would be enlarged.”

In view of the above, the petition is dismissed.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3211.

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